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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,444	09/19/2003	Michael O. Norris	18525-0784	4531

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PHILIP G. MEYERS LAW OFFICE
1009 LONG PRAIRIE ROAD, SUITE 302
FLOWER MOUND, TX 75022

EXAMINER

TRAN, KHOI H

ART UNIT PAPER NUMBER

3651

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,444

Applicant(s)

NORRIS ET AL.

Examiner

Khoi H Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 13-31 is/are pending in the application.
- 4a) Of the above claim(s) 23-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KHOI H. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/30 & 11/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group IV (method of processing a series of articles) and Species I (imager is a handheld device), in the reply filed on 11/29/2004, is acknowledged. The traversal is on the ground that the Restriction Requirement focused too much on slight differences in wording in the preamble of the original independent claims. This is not found persuasive because the claimed combinations in the independent claims were in fact different.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant presented new means-plus-function claims 24-31 and argued that the claims link the apparatus claims to the process claims. This argument is not persuasive because there is no apparatus claim presented. Furthermore, a manual action performed by a human operator cannot be claimed as a means for performing a function in a mean-plus-function claim. The "means for positioning" cannot be use.

3. Claim 23 is a subcombination claim directed to Group III of the Restriction Requirement. Since the linking claims 11 and 13 are not allowable, claim 23 has been withdrawn from consideration.

According to Applicant's election, claims 11, and 13-22 will be examine. Claims 23-31 have been withdrawn form consideration as being directed to non-elected inventions.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 11, 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenbaum et al. 5,031,223.

Rosenbaum '223 discloses a method of processing mail pieces per claimed invention. The method comprises positioning an OCR scanner above a mail piece to capture the address data on said mail piece, correlating, verifying said scanned data against address information held in a database, and printing a unique identification in the form of a barcode onto said mail piece after the OCR

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scanner scanned said mail piece (Figure 2). The method comprises forwarding the mail piece to a destination point that corresponds to the address data, if the scanned information is readable and verified. If the scanned data is not readable or not verifiable, the captured address data and image on the mail piece will be forwarded to a video coding system, at a workstation, so that an operator can manually modify the address data on a video screen (Figures 8-10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenbaum et al. 5,031,223 in view of IBM reference submitted by the Applicant, or in view of Koenck 6,688,523, or in view of Patel et al. 6,766,955.

Rosenbaum '223 discloses all elements per claimed invention. However it is silent as to the specifics of the OCR scanner being a handheld device.

IBM reference, Koenck '523, and Patel '955 disclose the commonly well-known portable handheld OCR scanning device for electronically identifying objects.

The limitation of the handheld OCR scanner in the instant claimed invention presents no novel or unexpected result over the OCR scanner used in

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the reference. Since portable handheld OCR scanners are commonly well known, as demonstrated by IBM, Koenck, and Patel '955, use of such portable OCR scanning means in lieu of the OCR scanner used in Rosenbaum '223 provides no stated problem and would be an obvious matter of design choice within the skill of the art. In re Launder, 42 CCPA 886, 222 F .2d 317, 105 USPQ 446 (1955).

Conclusion

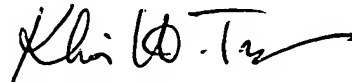
8. Additional references made of record and not relied upon are considered to be of interest to applicant's disclosure: see attached USPTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H Tran whose telephone number is (703) 308-1113. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on (703) 308-1113. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
01/17/2005